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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/066,795      | 02/06/2002  | Anthony Carroll      | 10473-839           | 5571             |

7590 09/02/2003  
MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

NGUYEN, TAN QUANG

| ART UNIT | PAPER NUMBER |
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3661

DATE MAILED: 09/02/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.



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|---------------------------------|-------------|---|---------------------|
| APPLICATION NO./<br>CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR /<br>PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---------------------------------|-------------|---|---------------------|

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| EXAMINER |
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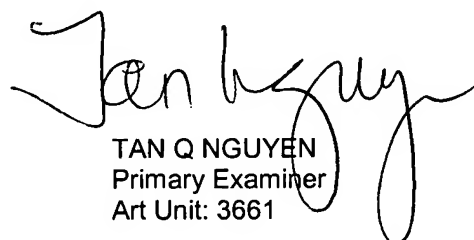
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14

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Commissioner for Patents

  
TAN Q NGUYEN  
Primary Examiner  
Art Unit: 3661

# Office Action Summary

Application No.

10/066,795

Applicant(s)

CARROLL ET AL.

Examiner

TAN Q NGUYEN

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAIL ACTION**

### ***Notice to Applicant(s)***

1. This CIP application has been examined. Applicant is noted that the last claim should be renumbered as claim 33 instead of 31, and which depends on claim 32 instead of 30. Correction/clarification is required. Claims 1-33 are pending (assuming the last claim is claim 33).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 3661

3. Claims 1-33 are rejected under 35 U.S.C. § 102(e) as being anticipated by Larson et al. (6,556,904).
4. As per claim 1, Larson et al. disclose the invention as claimed which includes the steps of providing the user interface for soliciting selection of desired service data (see at least figure 1), receiving an input signal representative of a selection of desired service data via data transmission network (see figure 3, steps 114, figure 4, item 119B), retrieving the desired service data and transmitting the desire service data to a data processing system via the data transmission network (see at least figure 2, step 110 or figure 3, step 116).
5. As per claim 2, Larson et al. further disclose that the service data is indexed by types of diagnoses and models (see at least figure 3, step 112).
6. As per claim 3, Larson et al. also disclose that the service data is used to converted signals representative of vehicle diagnosis state into a process diagnostic signal (see at least figure 2, step 104 and figure 4, steps 120, 122).
7. As per claim 4, Larson et al. disclose that the service data includes alignment specification (see at least figure 2).
8. As per claims 5-16, Larson et al. further disclose the steps of verifying the user in order to allow the downloading data and the billing process (see at least figures 3, 4 and the related text).
9. With respect to claims 17-33, the limitations of these claims have been noted in the rejections above and in the teaching of Larson et al. They are therefore considered rejected as set forth above.

### ***Conclusion***

10. All claims are rejected.

Art Unit: 3661

11. The following references are cited as being of general interest:

**Patents and PGPub :**

Weisshaar et al. (6,580,916), Larson et al. (6,442,460), Larson et al. (6,370,455), Kirkevold (6,263,322), Cherrington et al. (5,717,595) and Ikeda (2002/0049529).

**Articles:**

"Hunter Highlights", Hunter Engineering Co., vol. 70/2001, 4 pages, September 2001.

"Hunter Highlights", Hunter Engineering Co., vol. 57S/200, 4 pages, August 2000.

"WebSpecs Specification Database", Hunter Engineering Co., 2 pages, 2000 (month is not available).

Hunter Engineering Co. News Release, 1 page, January 15, 2001.

Hunter Engineering Co. product operating instructions for using WebSpecs WinAlign 5,1 and Above, 8 pages, September 2001.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Tan Nguyen, whose telephone number is (703) 305-9755. The examiner can normally be reached on Monday-Thursday from 5:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, can be reached on (703) 308-3873.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 305-7687, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park V, 2451  
Crystal Drive, Arlington, VA., Seventh Floor (Receptionist).

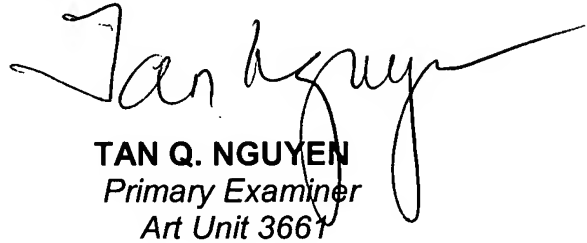
Application/Control Number: 10/066,795

Page 5

Art Unit: 3661

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

/tqn  
August 25, 2003



**TAN Q. NGUYEN**  
*Primary Examiner*  
Art Unit 3661